



PATENT
Customer No. 22,852
Attorney Docket No. 6890-11-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
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Kang Tae Lee et al.) Group Art Unit: 1616
)
Application No.: 09/927,338) Examiner: George M. Konata
)
Filed: August 13, 2001)
)
For: Skin Cosmetic Composition) Confirmation No.: 6837
Containing Kidney Bean Extracts)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE

In the Office Action of February 4, 2004, the Examiner continued to reject claims 5-10 for being anticipated by Miyamoto et al. (JP'109) and made the rejection final.

Applicants' invention relates to a method for suppressing wrinkle formation of human skin which comprises applying to said skin a skin cosmetic composition containing kidney bean extracts.

On the other hand, JP'109 relates to a cosmetic composition for the skin containing traumatic acid extracted from kidney bean pods.

Kidney bean extract and kidney bean pod extract are not the same thing as they contain different substances. In the Declaration of Kang Tae Lee filed October 23,

2003, Mr. Lee noted that kidney bean extract obtained from the kidney beans contained

four (4) components, whereas kidney bean pod extract, obtained from kidney bean pod, contained only one component, which was traumatic acid. While it was acknowledged that kidney bean extract contained traumatic acid too, it also contained at least three (3) other components not found in kidney bean pod extract. This was confirmed by the noted R_f values of kidney bean extract on page 4 of the declaration which showed it had one component having an R_f value (i.e., 0.73) the same as kidney bean pod extract and traumatic acid, as well as three (3) other components of different R_f values not found in kidney bean pod extract.

In the Office Action the Examiner argued that in spite of this data, the applicants had not indicated a "specific type of extract" and since traumatic acid is common in kidney bean extract and kidney bean pod extract, then it is reasonable "for one of ordinary skill in the art to use the traumatic acid as an extract in the claimed invention to achieve the desired results."

In response, enclosed for the consideration of the Examiner is a further declaration of Kang Tae Lee that specifically identifies at least two (2) of the other components of "kidney bean pod extract." Beginning on page 3, these are the components having R_f values of 0.64 and 0.58, neither of which as confirmed in this and the earlier Declaration are found in kidney bean pod extract. As noted on page 4 of the current Declaration, the component having a R_f value of 0.64 is phytic acid ($C_6H_{18}O_{24}P_6$) and that having a value of 0.58 is aspartic acid. Mr. Lee specifically confirms at the bottom of page 4 that kidney bean extracts contain not only traumatic acid, but also phytic acid and aspartic acid. Neither of these two components are found in kidney bean pod extract. See Table 1 on page 3 and the Declaration of October 23, 2003.

Accordingly, it is not seen how the claims of this application, all of which include “kidney bean extracts,” can be considered anticipated by JP’109, which only teaches “kidney bean pod extract.”

While the Examiner has only rejected the claims under §102, the arguments at the bottom of page 2 to the top of page 3 of the Office Action appear more in the nature of a rejection under §103. In other words, that in view of JP’109, which uses traumatic acid in a skin cosmetic, that it would be obvious to use the traumatic acid component of kidney bean extract to achieve the desired results.

In response, Mr. Lee compared the collagen synthesis of phytic acid (found in kidney bean extract and not found in kidney bean pod extract) with that of traumatic acid (See Table 3 of the Declaration). He found that the “collagen synthesis effect of phytic acid is far more excellent than traumatic acid.”

This then is one reason why, as set forth in the table beginning at the bottom of page 4 of the Declaration of October 23, 2003 and repeated in Table 4 in this Declaration, that the effects of kidney bean extract differ significantly from the effects of kidney bean pod extract or traumatic acid with respect to collagen synthesis. In other words, contrary to the Examiner’s opinion, it is not just the traumatic acid in the claimed kidney bean extract that achieves the desired result, but also at least the presence of the phytic acid component of the extract.

It is submitted that applicants have conclusively demonstrated that the claimed “kidney bean extracts” are not the same as the kidney bean pod extracts of JP’109 nor is the common ingredient in both (i.e., traumatic acid) the only component responsible for the desired results.

The claims then cannot be considered anticipated by or obvious in view of JP'109. Its withdrawal as a ground of rejection of the claims is therefore requested.

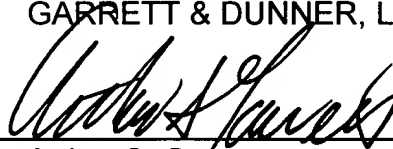
Since the Office Action of February 4, 2004 is a final Office Action, a Request for Continued Examination is being filed simultaneously with this Response to enable the Examiner to consider the Declaration at this time.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: August 4, 2004

By: 
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